

### **REMARKS**

#### **I. Status of the Application**

By the present Amendment, Applicant amends claim 12 to correct an informality. The amendments to claim 12 are not made for patentability reasons and do not narrow the scope of the claims. Accordingly, this amendment does not foreclose application of reasonable equivalents. Claims 1-14 are all the claims pending in the application. Claims 1-14 presently stand rejected.

The present Amendment addresses each point of objection and rejection raised by the Examiner. Favorable reconsideration is respectfully requested.

#### **II. Objections to the Drawings**

The Examiner has objected to the drawing filed February 22, 2005 alleging that the figures do not contain the reference sign for the movable guide 83. Applicant has amended the specification, as set forth above, to reference “the movable guide 82” rather than “the movable guide 83.” Therefore, the Examiner’s objections to the drawings are now moot.

#### **III. Claim Objections**

The Examiner has objected to claim 12 alleging various informalities. Claim 12 has been amended, as set forth above, to correct the informalities noted by the Examiner. Thus, Applicant respectfully requests that the Examiner withdraw these objections.

#### **IV. Claim Rejections Under 35 U.S.C. § 103**

Claims 1-10 and 12-14 are rejected under 35 U.S.C. § 103(a) as allegedly being anticipated by Oda (5,277,506) in view of Krieg et al. (4,265,556). Claim 11 is rejected under 35

U.S.C. § 103(a) as allegedly being unpatentable over Oda (5,277,506) in view of Wen (6,109,745). Applicant respectfully traverses these rejections for *at least* the reasons set forth below.

**A. Independent Claim 1**

The Examiner bears the initial burden of establishing *prima facie* obviousness. MPEP § 2142. To establish a *prima facie* case of obviousness the Examiner must establish that there is some suggestion or motivation, in either the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings. MPEP § 2142.

The Office Action acknowledges that Oda fails to teach or suggest the feature of a sensor that detects an edge that is guided by said fixed guide, as recited in claim 1. Nevertheless, the Examiner alleges that Krieg remedies the deficient teachings of Oda. Further, the grounds of rejection allege that it would have been obvious to one of ordinary skill in the art to either detect both edges or interchange the guides of the apparatus disclosed in Oda in view of Krieg since such a combination would allegedly be capable of achieving the predictable result of sensing either or both edges, at least one of which has a fixed guide, in order to determine the appropriate print start position as set forth in both Oda and Krieg,

Applicant respectfully disagrees with the grounds of rejection. A skilled artisan would not have had any reason to combine the teachings of Oda and Krieg in the manner proposed by the grounds of rejection so as to achieve the invention of claim 1. In fact, the teachings of Oda and Krieg teach away from such a proposed modification.

It is well-settled that the proper inquiry for obviousness is what the reference as a whole teaches or suggests to those of ordinary skill in the art. When the teachings of Oda are properly considered as a whole, it is clear that the objective of Oda is to do away with the necessity of moving the carrier 3 to the other side, which is opposite to the home position HP, in order to achieve a higher printing speed when the width of the paper is detected. *See e.g.*, column 2, line 5 – column 3, line 3. Accordingly, Oda teaches that the paper width can be automatically detected quickly and accurately only by slightly moving the carrier 3 from the home position in comparison with the prior art, wherein the carrier must be reciprocated a distance more than the paper width for the detection of the paper width. Column 2, line 66 – column 3, line 3.

However, if a skilled artisan were to modify the teachings of Oda in the manner proposed by the grounds of rejection, so that the sensor 11 detects an edge that is guided by the fixed guide (i.e., the fixed plate in FIG. 2) then the carrier would have to move to the other side opposite to the home position HP (see FIG. 2). Oda expressly teaches away from such a proposed modification in that the main objective of Oda is to increase printing speed by only slightly moving the carrier 3 from the home position, rather than the width of the paper.<sup>1</sup>

In fact, the modification proposed by the grounds of rejection would destroy Oda's particular contribution to the art (i.e., a printer in which the paper width can be automatically detected quickly, and accurately only by slightly moving the carrier 3 from the home position in

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<sup>1</sup> A reference that teaches away is a significant factor in determining obviousness and the nature of that teaching is highly relevant and must be weighed in substance. *See In re Gurley*, 31 U.S.P.Q.2d 1130 (Fed. Cir. 1994).

comparison with the prior art). Consequently, the teachings of Oda and Krieg are not sufficient to render the claims *prima facie* obvious under MPEP § 2143.01.

Therefore, claim 1 is patentable over the cited references for *at least* these reasons.

Further, Applicant submits that the dependent claims 2-10 are patentable *at least* by virtue of their dependency on claim 1. Thus, Applicant respectfully requests that the Examiner withdraw these rejections.

**B. Independent Claim 12**

Applicant submits that claim 12 is patentable over the cited references *at least* for reasons analogous to those presented above. Thus, the allowance of this claim is respectfully solicited of the Examiner.

**C. Independent Claim 13**

Applicant submits that claim 13 is patentable over the cited references *at least* for reasons analogous to those presented above. Thus, the allowance of this claim is respectfully solicited of the Examiner.

**D. Independent Claim 14**

Applicant submits that claim 14 is patentable over the cited references *at least* for reasons analogous to those presented above. Thus, the allowance of this claim is respectfully solicited of the Examiner.

**V. Conclusion**

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the

AMENDMENT UNDER 37 C.F.R. § 1.116  
Application No.: 10/525,239

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Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

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**23373**

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